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TI Law Group  
2055 Junction Avenue, #205  
San Jose CA 95131-2116

AUG 12 2010

**OFFICE OF PETITIONS**

In re Application of	:	
Kondrk et al.	:	
Application No. 10/687,534	:	DECISION ON RENEWED PETITION
Filed: October 15, 2003	:	PURSUANT TO
Attorney Docket No.: 101-	:	37 C.F.R. § 1.137(a)
P291/P3157US1	:	
Title: METHOD AND SYSTEM FOR	:	
SUBMITTING MEDIA FOR NETWORK-	:	
BASED PURCHASE AND DISTRIBUTION	:	

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.137(a), submitted on July 12, 2010, seeking the revival of the above-identified application.

The renewed petition pursuant to 37 C.F.R. § 1.137(a) is **DISMISSED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed August 4, 2009, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on November 5, 2009. A notice of abandonment was mailed on February 17, 2010.

**The Relevant Portion of the MPEP**

Section 711.03(c) (I) (A) sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in

view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question (emphasis added).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d

885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

### Analysis

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

An original petition pursuant to 37 C.F.R. § 1.137(a) was filed on April 16, 2010, along with an amendment and a statement of facts. The petition fee was received on June 15, 2010, and the original petition was dismissed via the mailing of a decision on May 25, 2010, which indicated that requirements (1) and (2) of Rule 1.137(a) had been satisfied, and that the fourth requirement is not applicable, as a terminal disclaimer is not required.<sup>1</sup>

With the original petition, Petitioner alleged that the Office communication was not received and that both his "office and file" were searched, and the non-final Office action was not located.<sup>2</sup> With this renewed petition, Petitioner has indicated that incoming Office correspondence is entered into the docketing system (which generates monthly reminder print-outs that are "provided to the responsible attorney") and a "separate manual calendaring" is made.<sup>3</sup> Petitioner has also provided a docket report that is associated with this particular application.

This renewed petition cannot be granted however, as the record is silent as to the issue of the **master docket**. The decision on the original petition set forth, *in pertinent part*:

<sup>1</sup> See Rule 1.137(d).

<sup>2</sup> Statement submitted concurrently with the original petition.

<sup>3</sup> Renewed petition, page 2.

...Petitioner has not provided a copy of the master docket, or stated that no such master docket exists and submitted other forms of evidence referenced in the portion of the MPEP reproduced above.

Decision on original petition, page 4.

To date, **Petitioner has not indicated whether or not a master docket exists**, and the only form of alternate evidence (of the type referred to in the portion of the MPEP referred to above) that has been provided is the docket report that is associated with this particular application.<sup>4</sup>

If reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Second Renewed Petition pursuant to 37 C.F.R. § 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Moreover, **Petitioner should include a copy of the "manual calendaring" for the relevant date.**

The alternate petition under 37 C.F.R. § 1.137(b) will be held in abeyance so as to afford Petitioner the opportunity to file a second renewed petition under the unavoidable standard. If Petitioner would prefer to seek revival under the unintentional standard, a response to this decision should be submitted with words to this effect.

Any submission in response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,<sup>5</sup> hand-delivery,<sup>6</sup> or facsimile.<sup>7</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>8</sup>

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that

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<sup>4</sup> With this renewed petition, Petitioner has included a sample of a "case tracking system - reminder list," however it does not cover the relevant period of time, as it is dated June 25, 1010.

<sup>5</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>6</sup> Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

<sup>7</sup> (571) 273-8300 - please note this is a central facsimile number.

<sup>8</sup> <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.<sup>9</sup> All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/  
Paul Shanoski  
Senior Attorney  
Office of Petitions

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<sup>9</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.